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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,953	11/02/2001	Roy W. Mattson JR.	RM449b	2927

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EXAMINER

FETSUGA, ROBERT M

ART UNIT	PAPER NUMBER
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3751

DATE MAILED: 03/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/005,953

Applicant(s)

MATTSON ET AL.

Examiner

Robert M. Fetsuga

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) 2-18, 20, 31, 32, 38-46 and 51-63 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 19, 21, 22, 33-35 and 47-49 is/are rejected.
- 7) ☒ Claim(s) 23-30, 36, 37 and 50 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4-6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. Applicant's election of Group II, Species V, Sub-species A, in Paper No. 8 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Accordingly, claims 2-18, 20, 31, 32, 38-46 and 51-63 are withdrawn from further consideration pursuant to 37 CFR 1.142(b). The examiner agrees Fig. 13 does not constitute a species.

2. The attempt to incorporate subject matter into this application by reference to U.S. patents at page 1 is improper because no particular subject matter has been indentified.

3. The drawings are objected to because reference numerals "30" and "31" denote different elements in Figs. 3 and 6, the leader for reference numeral "43" appears misdirected in Figs. 10 and 13, reference character "h" (pg. 21 ln. 26) is missing, reference numeral "1805" denotes different elements in Figs. 18/19 and 20, and cross-hatching is missing from Figs. 22 and 23. Correction is required.

Applicant is required to submit a proposed drawing correction in response to this Office action. Any proposal by applicant for amendment of the drawings to cure defects must consist of two parts:

a) A separate letter to the drafts person in accordance with MPEP 608.02(r); and

b) A print or pen-and-ink sketch showing changes in red ink in accordance with MPEP 608.02(v).

IMPORTANT NOTE: The filing of new formal drawings to correct the noted defect may be deferred until the application is allowed by the examiner, but the print or pen-and-ink sketch with proposed corrections shown in red ink is required in response to this Office action, and may not be deferred.

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Proper antecedent basis for the "housing means" and "faceplate means" set forth in claims 19 and 47, "pop off connection" set forth in claim 33, "pop off design means" set forth in claims 48 and 49, and "safety/sanitation port means" set forth in claim 50, could not be found in the specification.

5. The claim hierarchy does not appear to be in accordance with MPEP 608.01(m). Claims remaining at allowance may require renumbering.

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6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 19 and 47-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Zars.

The Zars reference discloses a combination comprising: housing means 15,30; and faceplate means 2 including pop off design means (Fig. 1), as claimed. Re claim 19, the Zars housing is structurally capable of being used "to support a

removable filter means" in the functionally recited manner.

Claim 47 is redundant to claim 19.

8. Claims 1, 19, 21, 22, 33-35, 47 and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by Watkins.

The Watkins reference discloses a combination comprising: a housing 24 including a mounting surface (part of tub), an input orifice 26, an output orifice 32 having a faceplate 80, a shape (Fig. 2), and a pop off connection 72 (note pg. 7 lns. 33-36); and a filter 10 including a collar 74, as claimed.

9. Claims 19 and 47-49 are provisionally rejected under 35 U.S.C. 103(a) as being unpatentable over Zars and Idland et al.

Although the housing means of the Zars combination does not include a filter, as disclosed, attention is directed to the Idland et al. (Idland) reference which discloses an analogous combination which further includes housing means 19 having a filter 50. Therefore, in consideration of Idland, it would have been obvious to one of ordinary skill in the art to associate a filter with the Zars housing means in order to remove impurities from the water.

10. Claims 1, 21, 22 and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zars and Watkins.

Re claim 1, although the Zars housing does not include a filter, as claimed, attention is directed to the Watkins

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reference which discloses an analogous housing which further includes a filter 10. Therefore, in consideration of Watkins, it would have been obvious to one of ordinary skill in the art to associate a filter with the Zars housing in order to remove impurities from the water.

Re claim 1, although the faceplate (means) of the Zars housing (means) is not vertical, as claimed, attention is again directed to Watkins which discloses a vertical faceplate 80. Therefore, in further consideration of Watkins, it would have been obvious to one of ordinary skill in the art to associate a vertical orientation with the Zars faceplate in order to enable installation on a tub side wall.

Re claims 22 and 33, although the Zars housing does not include a shape/connection, as claimed, attention is yet again directed to Watkins which discloses a shape/connection (pg. 7 lns. 33-36). Therefore, in yet further consideration of Watkins, it would have been obvious to one of ordinary skill in the art to associate a shape/connection with the Zars housing in order to facilitate manufacture.

11. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*,

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245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1 and 19/47 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 19 of prior U.S. Patent No. 6,395,167. This is a double patenting rejection.

13. Claims 21, 22, 23/24 and 30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21, 22, 23 and 24, respectively, of U.S. Patent No. 6,395,167. Although the conflicting claims are not identical, they are not patentably

distinct from each other because the pending claims are anticipated by the patented claims and anticipation is the epitome of obviousness.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The Baker et al. reference discloses a combination having features in common with the instant invention.

15. Claims 23-30, 36, 37 and 50 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

16. Applicant is referred to MPEP 714.02 and 608.01(o) in responding to this Office action.

17. Any inquiry concerning this communication should be directed to Robert M. Fetsuga at telephone number 703/308-1506 who can be most easily reached Monday through Thursday.



Robert M. Fetsuga
Primary Examiner
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